

**REMARKS**

**Interview**

The Applicant and his attorneys thank the honorable Examiner for the telephone interview conducted on or about 29 July 2003.

**Formal Matters**

In the Final Office Action the Examiner required correction of drawing informalities. To comply with the requirements, we are submitting black-and-white formal drawings for the Examiner's review and approval. The informalities in the drawings are believed to have been overcome by this submission.

**Substantive Matters**

Turning next to art rejections, the Examiner rejected claims 1, 7-10, 16-19, 25-28, and 34-40 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,558,339 to Perlman ("Perlman"). The Examiner wrote that "Perlman describes a player's phone number as an 'address' or 'network address' in a data network. However, due to privacy concerns, a player's phone number is not 'explicitly' shown to the opposing player. Rather, a screen name or handle, and identification code is sent and displayed by both computers. Therefore, the examiner contends that the screen name, handle, and/or identification code are equivalent to a player's telephone number because each are used to identify a particular player."

Initially we note that functional equivalence is not the same as obviousness. "In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the

components at issue are functional or mechanical equivalents.” MPEP § 2144.06 (citing *In re Ruff*, 256 F.2d 590, 118 U.S.P.Q. 340 (C.C.P.A. 1958)). It is well settled that the standard applicable to the determination of obviousness is whether the claimed matter would have been obvious to a person skilled in the art at the time of the invention. Existence of functional and mechanical equivalents simply does not force the conclusion that the subject matter as a whole would have been obvious. *E.g.*, *In re Flint*, 330 F.2d 363, 367-68, 141 U.S.P.Q. 299 (C.C.P.A. 1964).

A telephone number is not the same as a handle or another identifier. In fact, multiple players can call from the same telephone number using different handles. Our claim 2 expressly recites the display of the telephone numbers and the use of identifiers and indicators of the players. These are separate limitations. Therefore, the Examiner may not rely solely on perceived functional similarity in making a *prima facie* case of obviousness.

Moreover, this is not a case where the references of record merely fail to teach all of the limitations in the claims. Here, the sole reference cited against the claims 1, 7-10, 16-19, 25-28, and 34-40, Perlman, itself requires that telephone numbers not be displayed. In fact, Perlman goes to substantial length to discuss his privacy concerns and the steps he takes to eliminate telephone number display. See, for example, the following statements made by Perlman:

1. “For reasons of privacy, many users would not want to publish their phone numbers.” Perlman, at col. 3, lines 41-43.
2. “Notably, this phone number is kept internally within computer 65. *It is not displayed* nor made accessible to User A. This is an important privacy consideration.” Perlman col. 12, lines 14-17 (emphasis added).

3. "Although the phone number of User B is transferred to the computer of User A during step 7, *the phone number of User B is not made available to User A.*" Perlman col 13, lines 29-31 (emphasis added).

Perlman does not stop at merely not displaying the telephone number of one player to another player. He actively prevents a player who receives the phone call from obtaining the telephone number of the player who placed the call by disabling Caller ID service prior to placing the call: "Further, if User A is in a calling area where Caller ID service is provided, the correct touch-tone sequence to disable the call identification will be generated by the client application software in User A's computer prior to initiating a call. This provides complete privacy to User A." Perlman, at col. 13, lines 39-44. Perlman also introduces a scheme using call forwarding to prevent one player from learning the telephone number of another player. See Perlman, at col. 29, line 38 through col. 35, line 47.

Not only Perlman fails to suggest the modification of his apparatus to include telephone number display, but he vigorously teaches away from it, practically requiring that the telephone numbers not be displayed and underscoring the undesirability of displaying them time and again. Recall that "the prior art must suggest the desirability of the claimed invention" before a case of *prima facie* obviousness can be made. MPEP § 2143.01. In the present case, Perlman teaches *undesirability* of the claimed invention.

No *prima facie* case of obviousness can be made under the circumstances.

Claims 7, 16, 25, and 34 recite the limitation of speakerphone. In rejecting these claims, the Examiner wrote that Perlman teaches the use of speakerphone during the game at column 41, line 65 through column 42, line 56. We respectfully request that the Examiner re-read this portion of Perlman. In the cited portion Perlman teaches the use of conference calls. A conference call is "a

telephone call by which a caller can speak with several people at the same time.” MERRIAM-WEBSTER INC., MERRIAM-WEBSTER’S COLLEGIATE DICTIONARY (Elec. ed., ver. 1.2 1994-96). A speakerphone is “a combination microphone and loudspeaker device for two-way communication by telephone lines.” *Id.* These are different devices and teaching of one is not teaching of the other.

Claims 8, 17, 26, and 35 recite the limitation of wireless telephone. The examiner concluded that this limitation can be combined with Perlman because “[d]oing so enables a player the mobility to play the game remotely from traditional landlines.” We respectfully disagree, because Perlman teaches away from such combination.

Perlman focuses on the ability to play “twitch” games, *i.e.*, “games that require split-second game control by players and cannot tolerate arbitrary communication latencies or delays. These games are by far the most popular category of video games.” Perlman, at col. 2, lines 5-8. According to Perlman, twitch games cannot be played through a dial-up network because of the time delays in such networks. Perlman, col 2, lines 27-51. “As a result, remote multi-player twitch games can only be played through a direct telephone connection of one player to another player.” Perlman, col. 2, lines 53-55. Given the well known additional time delay associated with cellular networks, Perlman in fact teaches away from the use of cell phones to play games. For this reason, claims 8, 17, 26, and 35 are patentable over Perlman.

**CONCLUSION**

For the foregoing reasons, the Applicant respectfully submits that all pending claims are patentable. To discuss any matter pertaining to the instant Application, the Examiner is invited to call the undersigned attorney at (858) 720-9431.

Respectfully submitted,

Dated: 9/19/2003

Anatoly S. Weiser  
Anatoly S. Weiser  
*Intellectual Property Legal Counsel*  
6046 Cornerstone Court, Suite 156  
San Diego, CA 92121  
(858) 720-9431  
Reg. No. 43,229